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EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/547,540

Applicant(s)

ALLOCA ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 13-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-27, 29-33, 35-38, 40, 41, 50-65, 67, 68 and 129 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10 & 11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Amendment B, paper # 12, received on April 10, 2003 is acknowledged and entered. Claims 1, 10, 13, 29, 31, 32, 33, 37, 40, 41, 50, 51, 52, 56, 59, 64, and 68 have been amended. Claims 11-12, 28, 34, 39, 42-49, 66, and 69-128 have been canceled. Claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68, and 129 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed on April 10, 2003 have been fully considered and the examiner's comments are as follows:

2.1. With regards to the applicant's remarks (see amendment B, see page 15 ), objection to the Specification has been withdrawn.

2.2. Since claim 39 is canceled, Obvious type Double Patenting rejection against claim 39 is withdrawn.

2.3. Applicant's remarks about lack of motivation in combining references Hartman and Yamada (see amendment B, pages 16-18) have been fully considered but are not persuasive for following reasons:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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knowledge generally available to one of ordinary skill in the art. As demonstrated in the earlier Office action, on page 4, Hartman did not disclose displaying multiple groups/procurement options having information related to ordering the identified item. However, Yamada teaches displaying multiple groups/procurement options having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5, 6, 9, col. 1, lines 12-44, col. 2, lines 57-65, col. 3, lines 6-18, col. 4, lines 15-30,). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col. 1, lines 11-44, and col. 3, lines 6-19). See the following related court cases for combining references :

*In re McLaughlin*, 170 USPQ 209 (CCPA 1971)

"Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper."

*In re Sheckler*, 168 USPQ 716 (CCPA 1971)

It is not necessary that a reference actually suggest changes or possible improvements which applicant made.

*In re Fine*, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

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*Ex parte Clapp*, 227 USPQ 972 (BdPatApp&Int 1985)

"To support conclusion that claimed combination is directed to obvious subject matter, references must either expressly or impliedly suggest claimed combination or examiner must present convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of references' teachings."

*In re Bozek*, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

*In re Gershon, Goldberg, and Neiditch*, 152 USPQ 602 (CCPA 1967) "Although references do not disclose or suggest the existence of applicants' problem or its cause, claims are rejected under 35 U.S.C. 103 since references suggest a solution to problem; it is sufficient that references suggest doing what applicants did, although they do not teach or suggest exactly why this should be done, other than to obtain the expected superior beneficial results."

*In re Beattie*, 24 USPQ2d 1040 (CA FC 1992)

"Board of Patent Appeals and Interferences correctly held that it would be obvious to one having ordinary skill in art to combine prior art references in order to arrive at claimed marking system for reading and playing music on keyboard or stringed instruments, despite absence of single express teaching of marking system which combines two musical theories of prior art references, since law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as whole. "

*In re Dillon*, 16 USPQ2d 1897 (CA FC 1990)

"Each situation must be considered on its own facts, but it is not necessary in order to establish a prima facie case of obviousness that both a structural similarity between a claimed and prior art compound (or a key component of a composition) be shown and that there be a suggestion in or expectation from the prior art that the claimed compound or composition will have the same or a similar utility as one newly discovered by applicant."

*Orthopedic Equipment Company, Inc. et al. v. United States*, 217 USPQ 193 (CA FC 1983)

"Fact that two disclosed apparatuses would not be combined by businessmen for economic reasons is not same as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue. "

2.4. Applicant's arguments with regards to amended claims 1-8 (see amendment B, pages 18-19) have been fully considered but they are not persuasive. The limitation in the amended claim 1, "receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source" (see amendment B, pages 2 and 23) constitutes new matter. The examiner could not find support for the limitation, "a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source" in the specification. Lines 3-18 on page 25 of the specification disclose that multiple group order fulfillment information can have a unique purchaser-specific order information comprising: payment information, delivery address, delivery instructions, shipping instructions, etc. but they do not specify "a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source", as claimed. Since the newly added limitation constitutes new matter it is not been further treated on merits.

2.5. Applicant's arguments with regards to claims 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68 (see amendment B, pages 19-20) have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by Hartman/Yamada cited or the objections made. Further, they do not show how the amendments avoid such references or objections. Hartman/Yamada recite features, as demonstrated in the earlier Office action on pages 4-6, such as predefined order fulfillment information comprising delivery address/delivery information, shipping instruction, payment information/source (see at least Hartman FIGS. 1A-1C, 2-7, 8A-8C, col.2 line 50-col.5,

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line 63, and Yamada (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30).

2.6. Applicant's arguments with regards to pending dependent claims ( see amendment pages 20-21. Note: A general comment has been made without identifying dependent claims by their numbers) have been fully considered but they are not persuasive as Hartman/Yamada (see Hartman col.4, line 59-col.5, line 8, ".....The order confirmation section confirms that the order has been placed and provides an opportunity for the purchaser to review and change the single-action order....") can include changing the order, canceling the order or changing any other order requirements such as order fulfillment conditions/procurement options.

2.7. With regards to the applicant's remarks regarding the use of Official Notice in the earlier Office Action (see Amendment B page 21), in the updated status of the application after the Amendment B, the use of Official Notice is applicable for claim 8 only for displaying a default indication. Applicant's statement, "...While Applicants agree that defaults.....have been used generally, in the prior art, Applicants do not agree that it is obvious to use such techniques in the manner recited in the claims for which the Official Notice has been cited "s demanded by the applicant " and demand to produce a reference in support does not amount to seasonably challenging the Official Notice as per MPEP 2144.03. As per MPEP 2144.03 a challenge from the applicant to the taking of judicial Official Notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice. In their traversal the applicants have submitted neither information nor argument against the examiner's Official Notice for providing default programs to create on its face a reasonable doubt regarding the circumstances justifying the Official Notice. However, in order to expedite the prosecution of the application, the examiner has attached references from two separate books : (i) Yesil, Magdalena, " Creating the virtual store Taking your web site from

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browsing to buying “; Appendix G, pages 347-349-Overview of Shopping Client Features , published 1997,Wiley Computer Publishing, John Wiley & Sons, Inc.; New York, (see specially, page 348, “..Address and payment information management. With these features consumers can use default shipping addresses .....default payment types....eliminating the need to enter repetitive information for each transaction”, (ii) Microsoft Press Computer Dictionary, published, 1997; Redmond Washington, page 137, see definitions of “default---default button----default home page “.

In view of the foregoing and analysis the rejection of claims 1-10, 13-27, 29-33, 35-38, 40-41, 50-65, 67-68, and 129 is maintained.

This is a Final Action.

### ***Claim Rejections - 35 USC § 112***

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1-8 recite the limitation “ receiving indications of multiple groups of order fulfillment information that are each predefined for the user and that each include a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source “ (see amendment B, claim 1, pages 1-2 and 23) and that constitutes new matter. The examiner could not find support for this part of limitation , “a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source “ in the specification. Lines 3-18 on page 25 of the specification disclose that multiple

group order fulfillment information can have a unique purchaser-specific order information comprising : payment information, delivery address, delivery instructions, shipping instructions, etc. but they do not specify "a unique combination of a delivery address, shipping instructions distinct from the delivery address, and a payment source ", as claimed.

Claim 52 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 52 recite the limitation " wherein all of the procurement options are associated with a single user and wherein each of the procurement options is a unique combination of .....the user" (see amendment B, claim 52, pages 11 and 27) and this constitutes new matter. The examiner could not find support for this part of limitation in the specification. Specification teaches multiple procurement options embodiment for a plurality of users ( see specification, page 25, lines 3-18) and not associated to a single user only. Specification also teaches that multiple procurement options can be associated with a single user of a client system, that is, when the single user is used in the context of a particular client system, see claim 33.

Note: Since the newly added limitations in claims 1-8 and 52 constitute new matter they are not being further treated on merits for prior art rejection.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman, in view of Yamada (US Patent 6,336,100 B1).

Note: rejection of claims 1-7 and 52 is being done in the light of 35 U.S.C. 112, first paragraph rejection made above.

With regards to 1, 9, 10, 29, 31, 32, 33, 40, 41, 50, 56, 59, 64, 67, and 68, Hartman discloses a method, a system, a computer-readable medium, and a display device for assisting a user at a client system to place an order for an item to be received by a server system. The client system displays the information identifying the item, an element representing order fulfillment instructions for the identified item, receiving indication of the recipient with predefined order fulfillment information including a delivery address, shipping instructions, and a payment information/source-such that the payment information for procurement option will be used to pay for the identified item and such that delivery information for that procurement option will be used for the delivery of the identified item, and after selection by the user of a displayed indication, without further intervention, sending to server computer a request to order the identified item such that the identified item is to be sent to the delivery address for the selected recipient using the shipping instructions and to be paid for by the payment source for the selected recipient, so that a single action orders and pays for the item (see at least FIGS 1A-1C, 2-7, 8A-8C, col.2, line 50-col.9, line 53). Hartman also teaches to create new procurement option for ordering the identified item (see at least Fig.1B, "...Review or change your 1-click orders ", col.4, line 59-col.5, line 8). Hartman further teaches that a client identifier corresponds to multiple customers and these multiple customers can be identified by selecting a partially displayed purchaser-specific order information (see at least col.9, lines 54-63). Hartman does not expressly teach displaying

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multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item. Yamada, in the same field of online shopping, teaches displaying multiple groups/procurement options associated with a single user of the client system having information related to ordering the identified item and allowing the user to select one of the multiple groups/procurement options (see at least FIGS. 2, 4, 5,6,9, col.1, lines 12-44, col.2, lines 57-65, col.3, lines 6-18, col.4, lines 15-30,). In view of Yamada, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as expressly taught in Yamada. Doing so would allow the user the novelty and the convenience to order items online for different destinations for him and/or gifts for individuals other than him (see at least col.1, lines 11-44, and col.3, lines 6-19). Note: different destinations mean customer's/user's home addresses or customer's designated addresses such as company addresses and other addresses for individuals other than him as explicitly disclosed in Yamada (see at least col.1, lines 11-44, and col.3, lines 6-19). Please see the related court cases as listed above under "Response to Arguments" for combining references :

Hartman/Yamada further teaches all the limitations cited in claims 2-7, 13, 15-27, 30, 35, 37, 38, 51-55, 57-58, 60-63, 65, and 129, (see Hartman, col.2, line 51-col.10, line 14, and Yamada, col.1, line 19-col.5, line 20).

4.2. Claims 8, is rejected under 35 U.S.C. 103(a) as being obvious over Hartman/Yamada in view of Official Notice.

With regards to claim 8, Hartman/Yamada teaches a method for a user at a client system to place an order for an item, the user having a plurality of groups of predefined order

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fulfillment information as disclosed in claim 1 and analyzed above. Hartman/Yamada does not disclose displaying an indication selecting a default groups out of the identified multiple groups. Official Notice is taken of both the well-known concept and benefits of providing a default program while working on the computers when several choices are available to the user to select one. If a user does not specify an alternative the program makes a choice automatically. In view of this well-known concept and its benefits it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include default program in Hartman/Yamada because if a user wants the purchased item to be delivered at his home then he can save time by not being bothered to select delivery information (see at least Yamada, Fig.9, col.3, lines 6-19) as the default program will automatically indicate the server in Hartman/Yamada to select home address if the user has not made any selection of the available multiple groups.

4.3. Claims 14, and 36, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman/Yamada in view of Holland et al. (US Patent 6,493,742), hereinafter referred to as Holland.

With regards to claims 14, and 36, Hartman/Yamada teaches a method for a user at a client system to place an order for an item by indicating a single action, wherein the user have multiple procurement options of predefined order fulfillment information as disclosed in method claims 10, and 33, and analyzed above. Hartman/Yamada discloses indicating a selection of an option to deliver the item as a gift (see at least Yamada col3., lines 6-12). Hartman/Yamada does not disclose that the order request includes wrapping instructions for the item to be delivered. As per knowledge generally available wrapping gifts before delivering to the recipients is notoriously well known practice. In the same field of on online ordering gifts,

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Holland teaches including wrapping instructions while ordering a gift (see at least col.1, lines 26-46). In view of Holland and knowledge generally available it would have been obvious to a person of an ordinary skill in the art at the time of the invention to include the wrapping

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,149,055 to Gatto (received with IDS, paper # 11 teaches displaying multiple transactions on display screen and allowing the user to select the identifier against the desired transaction and after selecting a displayed indication the method and system sends to the computer/server system a request to order the identified transaction and to complete the transaction without further intervention (see at least abstract, col.2, line 50-col.4, line 7, col.4, lines 14-31, "...According to one embodiment, the GUI preferably comprises a plurality of "objects" commonly used with object-oriented programming 9e.g., list boxes, combo boxes, radio buttons, command buttons, check boxes, message boxes, etc.). Each of the user choices may be represented by one of the objects.....By pointing to and selecting one of the choices, the user specifies the transaction type desired. Once the transaction is selected, other objects on the GUI may be used to enable the user to select the relevant transaction parameters necessary to define the selected transaction....."). Gatto's teachings are clearly analogous to the problems and the solutions disclosed in the instant application relating to the claimed limitations of displaying multiple procurement/order fulfillment options representing various unique combinations of delivery information and payment information –which correspond to multiple transactions displayed in Gatto, and after selecting one indication the response is sent

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to server, without further intervention, enabling the ordering department to execute the desired procurement option. Gatto's teachings make such claimed limitations of the present application obvious. Also, Gatto's teachings are analogous to the Hartman's single action ordering.

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). instructions in Hartman/Yamada, while delivering a gift, because a wrapped gift provides more excitement to the recipient than an unwrapped gift.

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

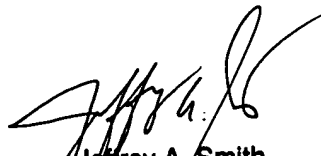
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg  
Examiner  
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YCG  
June 30, 2003



Jeffrey A. Smith  
Primary Examiner